

## AMENDMENTS TO THE DRAWINGS

The two attached sheets of drawings include changes to Fig. 1 and Fig. 5. These sheets replace the original sheets including Fig. 1 and Fig. 5.

## ATTACHMENTS: REPLACEMENT SHEETS

Replacement sheets for Fig. 1 and Fig. 5 are attached hereto.

## REMARKS/ARGUMENTS

The amendments and remarks hereto attend to all outstanding issues in the pending Office Action of 15 March 2006. Claims 12-30 are pending in this application as of the current Office Action.

### **In the Drawings**

FIG. 1 is amended to show screws previously discussed in the specification at page 5, lines 14-19, and to add a reference numeral for a hook that was previously shown (but was unlabeled). FIG. 5 is amended to provide reference numerals for screws that were previously shown (but were also unlabeled). The amendments to the drawings add no new matter to the application.

### **In the Specification**

Applicant has amended the specification:

(1) To refer to reference numerals 25 and 35, which indicate features already present in FIG. 1 and FIG. 5 but which reference numerals are newly added; to remove the words “(not shown)” in reference screws now shown as screws 25; and to note that only a few examples of screws 25 are shown in FIG. 1.

(2) To clarify that hooks 29, already shown in two places as associated with frame 52 in FIG. 1, may also be associated with frame 54 but are hidden due to the perspective view of FIG. 1.

(3) To change the words “loop member 34, loop member 36 and loop member 38” to “loop members 36, 37 and 38” to correct the reference numerals referring to the loop members shown in FIG. 5.

(4) To delete the words “cross,” “bar” and “crossbar” to improve consistency in referring to “the lateral restraint” or “the restraint” of a ski-lift chair.

(5) To improve grammar and consistency in use of reference numerals.

No new matter is added to the application through any of the specification amendments.

### **In the Claims**

Amendments to each of claims 12, 18, 19, 20, 21, 25 and 28 to change “frame member” or “the frame member” to “the at least one frame member” are grammatical in nature.

Claims 12 and 25 are also amended to change the limitation “semi-circular” to “semi-cylindrical” to correct a typographical error in the Amendment and Response filed on 28 December 2005. These amendments are supported by the specification as filed at page 6, lines 20-21. Also in claim 25, the word “a” is changed to “the” for proper antecedent basis of a term.

Claim 16 is also amended to clarify that each of the left and right frame members forms two hooks that couple with the body member, and is held in place by two screws that screw upwardly through holes formed by the body member into the respective frame member. This amendment is supported by FIG. 1 and in the specification as filed at page 5, lines 16-19.

Claim 19 is also amended to clarify that the body member and the at least one frame member form a leading edge that faces forwardly with respect to the ski-lift chair. This amendment is supported in the specification as filed at page 6, line 22 through page 7, line 2.

Claim 24 is amended to clarify that the body member form molded recesses for securing screws that screw upwardly into the molded recesses, to facilitate attaching the system to the lateral restraint. Claim 30 is amended to include screws that screw upwardly into the molded recesses. These amendments are supported by FIG. 5 (a bottom view, showing the screws that screw from the bottom into the molded recesses), by FIG. 1 and FIG. 2 (perspective and top views that do not show screws that screw from the top into the molded recesses) and by the specification as filed at page 6, lines 4-7.

No new matter is added to the application through the claim amendments.

### **Response to Office Action**

The following paragraphs follow the order of the paragraphs in the Office Action mailed 15 March 2006 in this application.

### **Drawings**

The Examiner objected to the drawings under 37 CFR 1.83(a), requiring that the screws defined in claims 13, 16, 31, 32 and 33 must be shown or the feature(s) canceled from the claim(s). Replacement sheets replacing the sheets that include FIG. 1 and FIG. 5 are submitted herewith to overcome this objection.

### **Claim Objections**

The Examiner objected to claims 12-33 because claims 12, 18, 19, 20, 21, 25 and 28 recite “the frame member” instead of the language “the at least one frame member” preferred by the Examiner. Claims 12, 18, 19, 20, 21, 25 and 28 have been correspondingly amended to overcome this objection.

### **Claim Rejections – 35 USC §102**

Claims 12, 19, 21 and 22 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 2,631,468 (“Thomas”). Applicant respectfully disagrees. To anticipate a claim, the reference must teach every element of the claim and “the identical invention must be shown in as complete detail as is contained in the ... claim.” MPEP §2131, citing *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

Claim 12, as amended, requires the following elements:

(a) a body member forming a downwardly facing, semi-cylindrical recess along a width of the body member so as to receive a lateral restraint of a ski-lift chair;

(b) at least one frame member that mounts over a top surface of the body member, the at least one frame member forming a viewable region;

(c) the at least one frame member and the body member configured for holding the printed media between the at least one frame member and the body member.

Applicant points out, first, that Thomas does not disclose element (a) of claim 12. “Semi-cylindrical” is understood to mean a profile that is semi-circular at a given cross-sectional plane, but has a straight axis, like a cylinder. Thomas’ body member (10) has a recess that curves along the width of the body member (see, e.g., Fig 2 of Thomas) and is therefore not semi-cylindrical.

Second, we point out that the semi-cylindrical recess is “along a width of the body member so as to receive a lateral restraint of a ski-lift chair” as also required by element (a) of claim 12. The recess disclosed in Thomas receives an automobile horn ring, not a lateral restraint of a ski-lift chair. The Examiner states “In regard to claim 25, as broadly defined, the bar (A) is considered to be a lateral restraint.” Office Action, page 4. Although the relevance of this remark is not clear, since claim 25 is not under this particular rejection, we disagree. Bar (A) as shown in Thomas is neither lateral nor a restraint, and is especially not a lateral restraint of a ski-lift chair, as required by claim 12. Furthermore, the record shows that this point is admitted by the Examiner with respect to a different claim rejection: “Thomas discloses the applicant’s basic inventive concept except for attaching the display to a restraint bar of a ski-lift chair.” Office Action, page 9.

For at least the reasons that Thomas does not disclose a body member forming a downwardly facing, semi-cylindrical recess along a width of the body member, and that Thomas does not disclose any recess so as to receive a lateral restraint of a ski-lift chair, we request reconsideration and withdrawal of the rejection of claim 12 under 35 U.S.C. §102(b) as anticipated by Thomas.

Amended claim 19 depends from claim 12 and benefits from like arguments. Further, claim 19 requires “the body member and the at least one frame member forming (a) a leading edge that faces forwardly with respect to the ski-lift chair, and (b) right and left sides, the leading edge being swept rearwardly along a width of the leading edge from a center of the leading edge towards the left and right sides.” The Examiner states that “In regard to claim 19, Thomas shows in figure 1 that the leading edge is sweep [sic] back.” Office Action, page 4. We disagree. First, Thomas designates no particular edge as a “leading edge,” especially not a “leading edge that faces forwardly with respect to the ski-lift chair.” Second, Thomas describes base (10) as generally rectangular: “The base is here shown as generally rectangular in plan and is denoted by the numeral 10.” Thomas, col. 2, lines 48-50. We therefore contend that Thomas does not disclose “the body member and the at least one frame member forming (a) a leading edge that faces forwardly with respect to the ski-lift chair, and (b) right and left sides, the leading edge being swept rearwardly along a width of the leading edge from a center of the leading edge towards the left and right sides” as

required by claim 19. We accordingly request reconsideration and withdrawal of the rejection of claim 19 under 35 U.S.C. §102(b) as anticipated by Thomas. Claims 21 and 22 depend from claim 12 and benefit from like arguments; we also request reconsideration and withdrawal of the rejection of claims 21 and 22 under 35 U.S.C. §102(b) as anticipated by Thomas.

Claims 12 and 13 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 2,507,875 (“Williams”). The Examiner maintains that “Williams shows in figures 1-5 a media display system comprising a body member (3) forming a downwardly facing, semi-circular recess (22 or 24) along a width of the body member, at least one frame member (4) that mounts over a top surface of the body member, and the frame member and the body member configured for holding a printed media (12) between the frame member and the body member. Downwardly is a relative term, and as broadly defined, the recess is considered to be downwardly facing.” Office Action, page 4. Respectfully, we will show below that the Examiner’s characterization of the elements of Williams, and what the Examiner considers “downwardly facing” is inconsistent with Williams’ disclosure. Furthermore, the Examiner’s view of Williams’ elements is inconsistent with the geometry required by claims 12 and 13. Therefore, Applicant respectfully contends that Williams does not disclose any of elements (a), (b) and (c) required by claim 12, as outlined above.

First, the figures and text of Williams leave no doubt about the relative direction of up and down associated with Williams’ “Advertising Sign Display Box” which is mounted on a vertical parking meter standard. “Another object is to provide a sign display box which may be ... easily and quickly assembled in place on vertical parking meter standards;” Williams, col. 1, lines 18-22. Also see FIG. 1, showing a vertical orientation of standard 5. “Body 2 fits on standard 5 below meter box 6...” Williams, col. 2, lines 6-7. “Each body half... has a perimetral enclosure or rim including a top end plate 8 and a bottom end plate 9...” Williams, col. 2, lines 9-11, note the corresponding positions of top end plate 8 and bottom end plate 9 in FIG. 1 through FIG. 4. “It is to be noted that this structure enables a display panel 12 to be inserted through slot 17 and slide up into opening 11...” Williams, col. 2, lines 25-27. “A similar semi-circular notch 24 is formed in the inner edge of the bottom end plate 9 of each case part. These notches mate in a position vertically alined [sic] with the notches

22 in the top end plates of the two case parts and likewise fit around standard 5.”  
Williams, col. 2, lines 38-43.

Therefore, since “up” is clearly the direction associated with “top plate 8” and “down” is clearly the direction associated with “bottom plate 9,” notches 22 and 24 are clearly not “downwardly facing” - in fact, Williams says explicitly that these notches are aligned vertically with respect to each other, so they must face sideways. Williams clearly does not describe the downwardly facing, semi-cylindrical recess along a width of the body member required by element (a) of claim 12, as amended.

Williams also does not disclose element (b) required by claim 12. As per the quotation above, the Examiner believes that Williams’ complementary half (3) is the “body member.” Therefore, for Williams to anticipate claim 12, the “frame member” must mount over a top surface of the “body member” as required by claim 12. But no consistent reading of terms such as “up,” “down,” “top” and “over” in Williams results in such a configuration. Williams clearly labels “top plate 8” in FIG. 1 through FIG. 4; complementary half (4) that the Examiner believes is the “frame member” clearly does not mount over this “top surface.” Alternatively, if complementary half (3) even could be described (which it cannot, as above) as having “downwardly facing” notches 22 and 24, then the “top surface” of half (3) would be the surface opposite those notches - which is where, in FIG. 3, Williams teaches opening (11) to be. It is evident that half (4) does not mount “over” this “top surface.” It is simply not possible to construe Williams’ complementary half (3) as having “downwardly facing” notches and to have complementary half (4) mount “over” its “top surface” as required by elements (a) and (b) of claim 12.

Furthermore, Williams also fails to disclose element (c) required by claim 12. Williams discloses a box body having complementary halves that are identical to each other: “The box body 2 is composed of two similarly formed complementary halves 3 and 4 which are ... duplicates of each other.” Williams, col. 2, lines 3-6. Williams discloses in FIG. 4 and FIG. 5 a slot that is formed in each of complementary halves 3 and 4 to hold a display panel. “The plates bounding opening 11 have inwardly extending flanges 13 along their outer edges forming a frame to enclose panel 12. Grooves 14 are formed in the inner faces of these flanges and are dimensioned to receive the edges of panel 12 with an easy sliding fit. Along the outer edge of top end

plate 8 a somewhat deeper flange 16 is formed. This is also provided with a groove 15 which is in the same plane as that of the side grooves. The bottom end flange 19 is provided with a slot 17. It is to be noted that this structure enables a display panel 12 to be inserted through slot 17 and slide up into opening 11 where it is retained in the frame composed of the top and side slots.” Williams, col. 2, lines 15-29. Therefore Williams discloses each of the complementary halves 3 and 4 holding a display panel in a slot formed in each of the halves, and does not disclose “holding the printed media between the at least one frame member and the body member” as required by element (c) of claim 12.

Since Williams does not disclose any of elements (a), (b) and (c) required by claim 12, Williams does not anticipate claim 12. We request reconsideration and withdrawal of the rejection of claim 12 under 35 U.S.C. §102(b) as anticipated by Williams.

Claim 13 depends from claim 12 and benefits from like arguments. However, the Examiner asserts that “In regard to claim 13, Thomas shows in figures 3 and 4 screws that screw ‘upwardly’ through holes formed by the body member into the frame member.” Office Action, page 4. First, we find the reference to Thomas confusing, insofar as it is contained within a rejection based on Williams. Second, in case the Examiner is truly referring to the Thomas patent, we note that Thomas does not show screws that screw in any direction into what Thomas calls “removable cover 16,” that the Examiner likens to a “frame member.” Fig. 3 of Thomas shows screws 26 and 34 screwing into base 10, while Fig. 4 of Thomas shows no screws at all. Third, in case the Examiner has erroneously referred to the Williams patent, as Thomas, we contend that Williams does not disclose screws that screw “upwardly” through holes formed by the body member into the frame member, for similar reasons as those given with respect to the directions of “up,” “down,” “top” and “over” in claim 12. For example, in FIG. 4, Williams clearly describes the direction of display panel 12 moving into slot 17 as “up” - but screws 25, also shown in FIG. 4, are oriented horizontally, not “upwardly.” FIG. 3 of Williams shows no screws at all, but shows securing lugs 26 oriented horizontally to receive such screws.

Since neither Williams nor Thomas discloses screws that screw upwardly, through holes formed by the body member, into the at least one frame member, neither



Williams nor Thomas anticipates claim 13 under 35 U.S.C. §102(b). Reconsideration and withdrawal of this rejection is therefore requested.

### **Claim Rejections – 35 USC §103**

The following is a quotation from the MPEP setting forth the three basic criteria that must be met to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Furthermore, a proposed modification cannot render the prior art unsatisfactory for its intended purpose:

If proposed modification would render the prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. [MPEP §2143, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)]

Claims 12, 14, 15, 18, 21-25, 29 and 30 stand rejected as being unpatentable over U.S. Patent No. 5,301,443 (“Gori”) in view of U.S. Patent No. 4,291,475 (“Schoemer”). Applicant disagrees, because (1) even when combined, Gori and Schoemer do not teach or suggest all the limitations of claim 12, that (2) the cited art, and the knowledge generally available to one of ordinary skill in the art, do not supply motivation to modify the cited art or to combine teachings, and that (3) Gori and Schoemer are directed to non-analogous art. Thus, a *prima facie* case of obviousness cannot exist under the criteria of *In re Vaeck*. Furthermore, the modifications proposed by the Examiner would render the prior art unsatisfactory for several of its intended purposes, so under *In re Gordon*, no motivation exists to combine the cited art. Finally, we also point out that Applicant’s invention as claimed has enjoyed commercial success, which demonstrates that the claims at issue are not “obvious,” per the attached Rule 132 Declaration.

First, we note that Gori and Schoemer do not teach all the limitations of claim 12. Element (a) of claim 12, as amended and as discussed above, requires a “semi-cylindrical recess along a width of the body member so as to receive a lateral restraint

of a ski-lift chair.” The Examiner contends that Gori shows “a display system including an elongate lateral restraint (173) ‘connectable’ to a ski-lift chair, a body member (7) and printed media (145, 147) placed on the body member. The body member (7) includes a downwardly facing, semicircular recess (see fig. 3) along a width of the body member.” Office Action, page 5. However, element (7) of Gori, which Gori calls a “cover member” and the Examiner calls a “body member” does not have a semi-cylindrical (or semi-circular) recess, and does not receive a lateral restraint of a ski-lift chair. Cover member (7) forms a recess having a series of flat sides, as can be seen in FIG. 2, FIG. 3, FIG. 6 and FIG. 7 of Gori; such a recess is not semi-cylindrical. Furthermore, the Examiner’s characterization of Gori’s shopping cart handle as an “elongate lateral restraint ‘connectable’ to a ski-lift chair” is incorrect. A shopping cart handle is not a lateral restraint, and whether anything is “connectable” to a ski-lift chair is irrelevant insofar as anything is “connectable” to anything else. Moreover, connection to a ski-lift chair would clearly render a shopping cart unsuitable for its intended purpose. Gori simply does not disclose a semi-cylindrical recess along a width of the body member so as to receive a lateral restraint of a ski-lift chair, as required by element (a) of claim 12.

Furthermore, Gori as modified by Schoemer does not disclose element (b) of claim 12. The Examiner correctly admits that “Gori does not disclose the idea of placing a frame member on the body member.” Office Action, page 5. But the Examiner goes on to state “Schoemer shows in figures 1-5 a body member (10), printed media (11), and a frame member (12) for securing the printed media to the body member.” Office Action, page 5. Respectfully, this statement mischaracterizes the requirement of claim 12 that the at least one frame member mount over a top surface of the body member. Fig. 4 of Schoemer show that what Schoemer calls a “transparent element or shield 12” and the Examiner calls “frame member (12)” does not mount over the top surface of what Schoemer calls “handset 10” and the Examiner calls “body member (10).” Instead, shield 12 inserts into slots 19 within handset 10, with a portion of handset 10 over a portion of shield 12, instead of the other way around. Furthermore, it is incorrect to characterize a “transparent shield” as a “frame member” in the first place, because the “shield” forms no “frame.”

Second, no motivation exists, either within Gori and Schoemer themselves, and the knowledge generally available to one of ordinary skill in the art, to combine such cited art. The Examiner claims that “In view of the teachings of Schoemer it would have been obvious to one in the art to modify Gori by providing a frame member for each of the printed media since this would allow the printed media to be protected in a better manner.” Office Action, page 5. But this is just speculation because Gori does not teach or suggest that the advertising sheets disclosed therein need any form of protection.

We also note that Gori is directed to a “Shoping [sic] Cart Handle Advertising Display Device.” Schoemer, on the other hand, discloses a “Labelling [sic] Device.” An inventor trying to solve a problem related to shopping cart handles would not turn to patents related to labeling devices for solutions, and vice versa. An inventor trying to solve a problem related to ski-lift displays would especially not turn to patents related to shopping cart handles or labeling devices for solutions. It can thus be fairly stated that Gori and Schoemer are non-analogous art to each other and to the art of ski-lift displays.

In addition, we again refer to the attached Rule 132 declaration.

Since Gori and Schoemer do not disclose all of the elements of claim 12, and no motivation exists to combine the teachings of Gori and Schoemer, and Gori and Schoemer are non-analogous art to each other and to the field of media displays for ski-lift chairs, we contend claim 12 is not obvious over Gori in view of Schoemer. We accordingly request reconsideration and withdrawal of the rejection of claim 12 under 35 U.S.C. §103(a) as unpatentable over Gori in view of Schoemer.

Claims 14, 15, 18 and 21-24 depend directly or indirectly from claim 12 and benefit from like arguments. However, these claims have other reasons for patentability over Gori in view of Schoemer.

For example, claim 18 requires the at least one frame member comprising downwardly projecting tabs, each tab comprising a latch tab, the body member comprising openings into which the latch tabs snap into place. The Examiner states that “Schoemer shows latch tabs (17) that cooperate with openings in the body member, the direction of the tabs is considered to be a matter of design choice.” Office Action, pages 5-6. However, the direction of the tabs is not a mere matter of design choice;

Applicant's specification teaches that downwardly projecting tabs are preferred because they can pass through holes in the printed media to help maintain registry of the media: "Such tabs provide registry and maintain the printed media flat, and smooth along the top surface 32 of the body member." Specification, page 5, lines 13-14. Schoemer's tabs do not provide registry of printed media. Absent a showing of prior art that includes the claim 18 limitation of downwardly projecting tabs, each tab comprising a latch tab, the body member comprising openings into which the latch tabs snap into place, Applicant contends that a case of *prima facie* obviousness has not been made for claim 18. Reconsideration is requested.

Claims 21 and 22 require that the body member and the at least one frame member, when integrated together, have a width, a thickness and a length, the thickness being less than one-half of the length (claim 21) or less than one-third of the length (claim 22). The Examiner states: "Gori shows in figures 1, 6, and 7 that the thickness is less than one-third of the length." Office Action, page 6. We point out respectfully that what Gori calls "cover member 7" and the Examiner calls a "base member" is but one of the elements that, must have a combined thickness of less than one-half or one-third of their length; that is, the claim limitation does not apply solely to Gori's "cover member." Furthermore, we believe that the Examiner's observations about the dimensions of cover member 7 alone are incorrect. For example, FIG. 1 of Gori does not even show a length: "FIG. 1 is an exploded side elevation of the advertisement display device." Gori, col. 2, lines 9-10. A side elevation does not show length. FIG. 2 of Gori, not FIG. 6 or FIG. 7, provides the clearest side view of cover member 7 alone. In Applicant's copy of Gori's FIG 2, cover member 7 is about 44 millimeters in width and 24 millimeters in height. Therefore, Gori shows a "body member" having a thickness that is more than one half of its length, not less than one-half or less than one-third of its length. A frame member that mounts over a top surface of the body member could only make the thickness even greater as compared to the length of the body member. Since Gori in view of Schoemer does not show this element of claims 21 and 22, reconsideration of the rejection of these claims is requested.

Claim 23 requires "the width being at least six times the length." The Examiner states, *inter alia*, that "the length of the width taught by Gori in view of Schoemer would work equally as well..." Office Action, page 6. We respectfully disagree and

point out that Gori in view of Schoemer does not point out a specific “length of the width” as the Examiner states. However, assuming that the Examiner meant to say “a width being at least six times the length,” note that FIG. 10 of Gori shows an example of a display device 175 that is, in Applicant’s copy, about six millimeters long and sixteen millimeters wide. Device 175 is approximately centered on shopping cart handle 173, and this appears to be so that portions of shopping cart handle 173 remain available for a human to push cart 171. The minimum length of device 175 appears to be limited by the size of handle 173 and room for Gori’s base member 9 and cover member 7 to engage screws required to clamp the base member to the cover member about handle 173. Therefore, in order to make device 175 at least six times its length, it would have to be about 36 millimeters wide in the scale of FIG. 10. However, shopping cart handle 173 as shown in FIG. 10 is only about 38 millimeters wide. A device 175 that is about 36 millimeters wide in the scale of FIG. 10 (that is, about 2 1/4 times as wide as device 175 as shown) would leave insufficient room on either side to easily grasp and maneuver handle 173. Therefore it is not true that “a width being at least six times the length” would “work equally as well...” - in fact, it would be so intrusive so as to render Gori’s invention unsuitable for its intended purpose. Since a modification that renders an invention unsuitable for its intended purpose nullifies the motivation to modify the reference, claim 23 is not obvious, as per *In re Gordon*. We request reconsideration and withdrawal of the rejection of claim 23 under 35 U.S.C. §103(a) as unpatentable over Gori in view of Schoemer.

Claim 24, as amended, requires “the body member forming molded recesses for securing screws that screw upwardly into the molded recesses, to facilitate attaching the system to the lateral restraint.” The Examiner states that “Gori shows in figure 6 that the body member includes recesses for securing screw [sic].” Office Action, page 6. We respectfully point out that the amendment to claim 24 clarifies that the screws must screw upwardly into the molded recesses, and that FIG. 6 of Gori shows screws that screw downwardly into molded recesses. Since Gori (and/or Schoemer) do not teach the limitations of claim 24, as amended, we request reconsideration and withdrawal of the rejection of claim 24 under 35 U.S.C. §103(a) as unpatentable over Gori in view of Schoemer.

On page 5 of the current Office Action, the Examiner lists claim 25 as rejected under 35 U.S.C. §103(a) as unpatentable over Gori in view of Schoemer, but directs no remarks to claim 25 in explanation thereof. Claim 25 is an independent claim including features not present in claims 12-23, and therefore the rejection of claims 12-23 is not equally applicable to claim 25. Applicant suggests that the Examiner inadvertently included claim 25 in this particular list of rejected claims. However, in case the listing was intentional, Applicant points out that Office policy places the burden of establishing *prima facie* obviousness on the Examiner, and entitles patent applicants to a clear and complete showing of grounds for rejection:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. MPEP §2142.

Where a claim is refused for any reason relating to the merits thereof it should be “rejected” and the ground of rejection fully and clearly stated, and the word “reject” must be used. ... A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group. MPEP §707.07(d).

Absent a showing of *prima facie* obviousness to the contrary, Applicant contends that claim 25 is not unpatentable under 35 U.S.C. §103(a) over Gori in view of Schoemer. If the Examiner disagrees, Applicant reserves the right to respond to a corrected or subsequent non-final Office Action that clearly explains the Examiner’s reasons for such rejection.

Claims 29 and 30 depend from claim 25 and benefit from the above arguments. Therefore Applicant requests reconsideration and withdrawal of the rejection of claims 29 and 30 as unpatentable under 35 U.S.C. §103(a) over Gori in view of Schoemer. However, there are further reasons for the patentability of claims 29 and 30. For example, claim 30, as amended, requires “screws that screw upwardly into the molded recesses.” As noted above in connection with claim 24, Gori discloses screws that screw downwardly, not upwardly into molded recesses. Since Gori (and/or Schoemer) do not teach the limitations of claim 30, as amended, we request reconsideration and withdrawal of the rejection of claim 30 under 35 U.S.C. §103(a) as unpatentable over Gori in view of Schoemer.

Claims 19 and 20 stand rejected as being unpatentable over Gori in view of Schoemer as applied to claim 12, and further in view of U.S. Design Patent No. 206,518 (“Evans”) or U.S. Design Patent No. D419,604 (“Emmett”). First, Applicant notes that claims 19 and 20 depend from claim 12 and benefit from the arguments for patentability of claim 12 discussed above. Applicant further disagrees with the rejections of claims 19 and 20 on the grounds that the cited art, even when combined, does not teach or suggest all of the claim limitations, that there is no motivation to combine the cited art, and that the cited art is non-analogous to Applicant’s field of endeavor.

Claim 19, as amended, requires that the body member and the at least one frame member forming (a) a leading edge that faces forwardly with respect to the ski-lift chair, and (b) right and left sides, the leading edge being swept rearwardly along a width of the leading edge from a center of the leading edge towards the left and right sides. The Examiner states: “Evans shows in figure 1 a card holder that includes the idea of sweeping the leading edge rearwardly. Emmett shows in figure 1 a sign that includes the idea of sweeping the leading edge rearwardly. In view of the teaching of Evans or Emmett it would have been obvious to one in the art to modify Gori by sweeping the leading edge rearwardly since this would create a more amusing, aesthetically pleasing, and safer sign, i.e. the rounded ends would be safer.” Office Action, page 6. However, we respectfully assert that the Examiner’s characterization of Evans and Emmett is incorrect. Evans and Emmett do not define a “leading edge” in any sense, especially not a “leading edge that faces forwardly with respect to the ski-lift chair.” Evans shows an identification card holder that has angled sides that cannot fairly be called “swept.” Emmett shows an oval-shaped sign that also cannot fairly be called “swept.” Thus, the cited art does not teach or suggest the limitations of claim 19.

Furthermore, the Examiner’s statements of motivation for combining either of Evans and/or Emmett with Gori and/or Schoemer are insufficient to establish such motivation without the benefit of speculation and/or hindsight. Nothing in Gori, Schoemer, Evans and/or Emmett teaches or suggests that a swept edge - which is not shown in any case - would be “more amusing” or “aesthetically pleasing.” Such statements are, again, speculation. Also, Gori already provides rounded corners; see, for example, FIG. 4, FIG. 5 and FIG. 8 of Gori. It is not clear that a “swept” edge

would create a “safer sign” that that already shown in Gori, this contention of the Examiner is speculation and made from a perspective of hindsight.

Finally, we point out that all of the cited art is non-analogous art with respect to each other and especially with respect to Applicant’s disclosure. Gori is directed to a “Shopping Cart Handle Advertising Display Device,” Schoemer discloses a “Labelling Device,” Evans discloses an “Identification Card Holder,” and Emmett discloses a “Combined Sign and Support Bracket.” One skilled in any of these arts would not consult the others for guidance, and one skilled in media display systems for ski-lift chairs would not consult any of them.

Because the cited art, even when combined, do not teach or suggest all of the claim limitations, and there is no motivation to combine the cited art, and the cited art is non-analogous to Applicant’s field of endeavor, we contend that claim 19 is not obvious over Gori and Schoemer in view of Evans and/or Emmett. Reconsideration and withdrawal of the rejection of claim 19 under 35 U.S.C. §103(a) as unpatentable over Gori and Schoemer in view of Evans and/or Emmett is requested.

Claim 20 depends from claim 19 and benefits from like arguments. Furthermore, claim 20 as amended requires the top surface being convex along a direction from the leading edge to a rear edge formed by the body member and the at least one frame member. The Examiner states that “Gori shows in figures 6 and 7 a convex top surface which is formed by the body member and frame member. Since the frame member is supported on the body member it would follow the shape of the frame member.” Office Action, page 6. Applicant disagrees, and points out that the Examiner’s first statement is inconsistent with the arguments used to reject claim 12 over Gori in view of Schoemer, and the second statement is factually incorrect. In the rejection of claim 12, the Examiner argues that Gori provides a body member and that Schoemer provides a frame member. But in this rejection, the Examiner states that Gori shows a “top surface which is formed by the body member and frame member.” We request that the Examiner clarify which position is being taken. We further note that it is not necessarily true that if “the frame member is supported on the body member it would follow the shape of the frame member.” For example, FIG. 6 of Gori shows cover member 7 being supported by shopping cart handle 50. Although resilient spacer pad 55 tends to obscure the visual picture (because it compresses where the pressure is



greatest), it is clear both from FIG. 6 and especially from FIG. 2 of Gori that a supported structure need not have the same shape as the underlying support. Since, alone or combined, Gori, Schoemer, Evans and Emmett do not show a top surface being convex along a direction from the leading edge to a rear edge formed by the body member, the elements of claim 20 are not taught.

The arguments recited with respect to claim 19 about lack of motivation to combine cited art, and the cited art being non-analogous art, apply also to claim 20. Because the cited art, even when combined, does not teach or suggest all of the claim limitations, and there is no motivation to combine the cited art, and the cited art is non-analogous art, we contend that claim 20 is not obvious over Gori and Schoemer in view of Evans and/or Emmett. Reconsideration and withdrawal of the rejection of claim 20 under 35 U.S.C. §103(a) as unpatentable over Gori and Schoemer in view of Evans and/or Emmett is requested.

Claims 26 and 27 stand rejected as being unpatentable over U.S. Patent No. Gori in view of Schoemer as allegedly applied to claim 25, and further in view of a patent that appears to be intended as U.S. Patent No. 5,410,827 ("Smith").

Applicant notes that claims 26 and 27 depend from claim 25 and would benefit from like arguments for patentability in the event that the Examiner establishes *prima facie* obviousness, but as noted above, the Examiner failed to direct any remarks to claim 25 and thus has not established *prima facie* obviousness. Therefore on these grounds, Applicant requests the reconsideration and withdrawal of the rejection of claims 26 and 27.

We also note that the Office Action listed one patent as "Smith (U.S. Patent No. 5,301,443)," but patent 5,301,443 is the Gori patent. From the Examiner's remarks, and from a previous Notice of References Cited in the present application, it appears to Applicant that what was intended was U.S. Patent No. 5,410,827 to Smith. The remarks below therefore assume that U.S. Patent No. 5,410,827 was the intended cited art; Applicant reserves the right to respond to a corrected or subsequent non-final Office Action if this assumption is incorrect.

Claim 26 requires "the printed media being protected by a clear plastic film that is at least several mils in thickness." The Examiner directs no arguments, directly, or

indirectly, to claim 26. Applicant refers to the explanation of Office Policy in MPEP §2142 and §707.07(d) as cited in connection with claim 25, above. Absent a showing of *prima facie* obviousness to the contrary, Applicant contends that claim 26 is not unpatentable under 35 U.S.C. §103(a) over Gori in view of Schoemer and further in view of Smith, and requests reconsideration and withdrawal of the rejection of claim 26. If the Examiner disagrees, Applicant reserves the right to respond to a corrected or subsequent non-final Office Action that clearly explains the Examiner's reasons for such rejection.

Claim 27 requires "the printed media comprising imagery that is reverse printed on a bottom side of a clear plastic film." We point out that the cited art is non-analogous art with respect to Applicant's field of endeavor. Gori is directed to a "Shopping Cart Handle Advertising Display Device," Schoemer discloses a "Labelling Device" and Smith discloses a "Window Badge." One skilled in any of these arts would not consult the others for guidance, and one skilled in media display systems for ski-lift chairs would not consult any of them. Reconsideration and withdrawal of the rejection of claim 27 under 35 U.S.C. §103(a) as unpatentable over Gori and Schoemer in view of Smith is requested.

Claims 23 and 24 stand rejected as being unpatentable over Thomas. Applicant disagrees and first, points out that claims 23 and 24 depend directly or indirectly from claims 12 and/or 21, argued above as patentable, and benefit from like arguments.

Furthermore, in regards to claim 23, the Examiner correctly admits that Thomas does not disclose making the width at least six times the length, then continues: "It would have been an obvious matter of design choice to make the width six times the length since the applicant fails to define any advantage to making the width six times the length and the length of the width taught by Thomas would work equally as well and it is considered within one skilled in the art to vary the size of the width relative to the length as desired." Office Action, page 7. Applicant points out that this sentence is confusing, especially the phrases "the length of the width taught by Thomas" and "it is considered within one skilled in the art." Applicant suggests that the intended statements were "a length six times the width taught by Thomas would work equally as well" and that "it is considered within the level of ordinary skill in the art." Applicant therefore replies to the Examiner's statements assuming these clarifications, and

reserves the right to respond to a corrected or subsequent non-final Office Action if these assumptions are incorrect.

Applicant disagrees that the modification suggested by the Examiner, that is, that “a length six times the width taught by Thomas would work equally as well” for the intended application of an automobile horn ring press button. Thomas points out that “it is an objective to provide a relatively large button which is of sufficient areal extent to reside within easy-to-reach range of the operating thumb...” Thomas, col. 1, lines 25-28. Therefore, a maximum distance between a steering wheel and Thomas’ horn ring press button is defined by the typical size of a human thumb, and we can presume that the device indicated by the numeral 8 in Fig. 1 of Thomas is an example thereof. Device 8, on Applicant’s copy of Thomas, measures about 8 millimeters in length and just under 16 millimeters in width. The 8 millimeter length, in the scale of Fig. 1, is required to make device 8 big enough to be in “easy-to-reach range of the operating thumb.” Thomas also says that the base, and thus the overall aspect of device 8, is generally rectangular: “The base is here shown as generally rectangular in plan and is denoted by the numeral 10.” Thomas, col. 2, lines 48-50. Therefore, a device as envisioned by the Examiner would be generally rectangular, 8 millimeters in length (to make it reachable by an operating thumb), but about 48 millimeters in width. It can easily be seen that a rectangular button 8 millimeters in length and 48 millimeters in width, in the scale of Fig. 1, would touch the steering wheel, at least making the horn mechanism inoperable, and also making steering difficult due to the need for a driver to carefully place his or her hands around the button. Therefore the modification proposed by the Examiner renders the cited art unsuitable for its intended purpose, so that there is no motivation for the modification. Applicant also points out that there is certainly no motivation taught or suggested in Thomas to apply the concept of an automobile horn ring press button to a media display system for a ski-lift chair.

Second, Thomas is non-analogous art, being related to the art of automobile horns, as opposed to Applicant’s field of endeavor, media display systems for ski-lift chairs. One seeking a solution for a media display system for a ski-lift chair would not look to the art of automobile horns for a solution.

Therefore, on the grounds that (1) there is no motivation taught or suggested by the references themselves, or in the knowledge generally available to one of ordinary

skill in the art, to modify the references or to combine reference teachings, and (2) that Thomas is non-analogous art to Applicant's field of endeavor, Applicant contends that Thomas does not teach or suggest the elements of claim 23 except in impermissible hindsight. We accordingly request the reconsideration and withdrawal of the rejection of claim 23 as unpatentable under 35 U.S.C. §103(a) over Thomas.

In regards to claim 24, the Examiner "takes official notice that it is known to form molded screw recesses." Office Action, page 7. We disagree, and request evidence supporting the Examiner's official notice, pursuant to MPEP §2144.03(C). We also point out, again, that Thomas is non-analogous art to Applicant's field of endeavor, being related to the field of automobile horns; a person seeking solutions for media display systems for ski-lift chairs would not look to such a field except in impermissible hindsight. We accordingly request the reconsideration and withdrawal of the rejection of claim 24 as unpatentable under 35 U.S.C. §103(a) over Thomas.

Claims 14-17 stand rejected as being unpatentable over Thomas in view of U.S. Patent No. 4,217,711 ("Spresser"). First, Applicant points out that each of claims 14-17 depends directly or indirectly from claim 12, argued above as patentable over the art of record, and thus claims 14-17 benefit from like arguments. Applicant further disagrees with the rejections of claims 14-17 on the grounds that (1) even when combined, Thomas and Spresser do not teach or suggest all the limitations of these claims, that (2) the references themselves, and the knowledge generally available to one of ordinary skill in the art, do not supply motivation to modify the references or to combine reference teachings, and that (3) Thomas and Spresser are directed to non-analogous art.

Claim 14 requires "the at least one frame member including a central frame member, a left frame member and a right frame member." With respect to claim 14, the Examiner states, *inter alia*: "Spresser et al. shows in figures 1 and 2 a frame member (26) that includes two frame members (one receives card 104 and the other card 106)." Office Action, page 8. Respectfully, this statement mischaracterizes the disclosure of Spresser, which actually refers to element 26 as "a generally rectangular cover member 26." Spresser, col. 2, lines 62-63. Furthermore, the Examiner first states that frame member 26 is a frame member, then, that it is two frame members. It cannot be both, and in fact Spresser does not actually teach frame members at all, but rather teaches "a generally rectangular cover member." Therefore Spresser (and/or Thomas) do not teach

or suggest the “a central frame member, a left frame member and a right frame member” limitations of claim 14.

The Examiner goes on to state: “In view of the teachings of Spresser et al. it would have been obvious to one in the art to modify Thomas by forming multiple frames on the frame member since this would allow multiple display sheets to be displayed at the same time. It is considered within one skilled in the art to vary the number of frames as desired, i.e. to form three frame members instead of two in order to allow more information sheets to be displayed.” Office Action, page 8. Applicant disagrees with the Examiner’s theory of motivation for combining these references. An automobile driver certainly does not need or want more information sheets to be displayed on a button whose stated purpose is to provide easy-to-reach access to a horn ring. A shopper certainly does not need easy-to-reach access to a horn ring.

Finally, Thomas and Spresser are non-analogous art, related to completely different fields of endeavor from each other and from the instant application. Thomas is related to the field of automobile horns. Spresser is related to the field of advertising display units for shopping carts. Neither relates to the field of media display systems for ski-lift chairs.

Since Thomas and Spresser do not teach or suggest all of the elements of claim 14, and no motivation exists to combine the teachings of Thomas and Spresser, and Thomas and Spresser are non-analogous art to each other and to the field of media displays for ski-lift chairs, we contend that claim 14 is not obvious over Thomas in view of Spresser. We accordingly request reconsideration and withdrawal of the rejection of claim 14 under 35 U.S.C. §103(a) as unpatentable over Thomas in view of Spresser.

Claims 15-17 depend from claim 14 and benefit from like arguments, and accordingly we request reconsideration and withdrawal of the rejection of claim 14 under 35 U.S.C. §103(a) as unpatentable over Thomas in view of Spresser. However, claims 15-17 include other limitations that patentably distinguish over Thomas in view of Spresser.

For example, claim 16 as amended requires “each of the left and right frame members (a) forming two hooks that couple with the body member, and (b) being held in place by two screws that screw upwardly, through holes formed by the body member,

into the respective frame member.” The Examiner notes “In regard to claim 16, Thomas shows in figures 3 and 4 screws (26) and hooks (28,28).” Office Action, page 8. However, the elements cited by the Examiner do not teach each of the left and right frame members forming two hooks that couple with the body member, and being held in place by two screws that screw upwardly, through holes formed by the body member, into the respective frame member. First, Thomas and/or Spresser do not teach left and right frame members at all, as noted above. Second, the hardware cited by the Examiner does not teach or suggest the limitations of claim 16 as amended. In Fig. 3 of Thomas, screws 26 hold a clasp 20, with screws that do not screw upwardly, through holes formed by the body member, into the respective frame member, but instead screw into base 10. Furthermore, Thomas’ “frame member” 16 does not form two hooks, as required by claim 16; instead, clasp 20 includes a lateral keeper 28: “Each clasp is of suitable spring metal and is denoted by the numeral 20 and is suitably shaped, has a notch 22 to clear the ring A and has inturned attaching ears or lugs 24-24 held in place by fastening screws 26. The lateral keeper as best shown in Figure 4, for example, fits into the keeper groove to hold the cover removably in place.” Thomas, col. 3, lines 27-34.

Since Thomas in view of Spresser does not teach or suggest the limitations of claim 16 as amended, and because no motivation exists to combine the teachings of Thomas and Spresser, and Thomas and Spresser are non-analogous art to each other and to the field of media displays for ski-lift chairs, we contend that claim 16 is not obvious over Thomas in view of Spresser. We accordingly request reconsideration and withdrawal of the rejection of claim 16 under 35 U.S.C. §103(a) as unpatentable over Thomas in view of Spresser.

Claim 17 requires “the left and right frame members each forming a downwardly facing, semi-circular recess to accommodate the lateral restraint.” The Examiner states that “Thomas shows in figure 4 that the frame member includes semi-circular recesses (the inner member of the frame member are curved at each end) at each end of the frame member.” However, this is incorrect. First, it is noted that the Examiner calls Thomas’ removable cover 16 a “frame member” in the rejection of claim 12 under 35 U.S.C. 102(b) over Thomas. But Fig. 2, Fig. 3 and Fig. 4 of Thomas actually show that Thomas’ clasp 20, not removable cover 16, has the notch 22 that the

Examiner likens to a “semi-circular recess.” Also, see Thomas at col. 3, lines 27-34 as quoted above.

Since Thomas in view of Spresser does not teach or suggest the limitations of claim 17, and because no motivation exists to combine the teachings of Thomas and Spresser, and Thomas and Spresser are non-analogous art to each other and to the field of media displays for ski-lift chairs, we contend that claim 17 is not obvious over Thomas in view of Spresser. We accordingly request reconsideration and withdrawal of the rejection of claim 17 under 35 U.S.C. §103(a) as unpatentable over Thomas in view of Spresser.

Claims 25 and 30-33 stand rejected as being unpatentable over Thomas in view of U.S. Patent No. 5,685,095 (“DeMasi”). Applicant disagrees on the grounds that (1) even when combined, Thomas and DeMasi do not teach or suggest all the limitations of claim 25, that (2) the cited art, and the knowledge generally available to one of ordinary skill in the art, do not supply motivation to modify the cited art or to combine teachings, and that (3) Thomas and DeMasi are directed to non-analogous art. Thus, claims 25 and 30-33 are not obvious over Thomas in view of DeMasi, under the criteria of *In re Vaeck*. Furthermore, the combination proposed by the Examiner would render the prior art unsatisfactory for several of its intended purposes, so under *In re Gordon*, no motivation exists to combine the cited art. Finally, we also point out that Applicant’s invention as claimed has enjoyed commercial success, as demonstrated by the attached Rule 132 Declaration.

Claim 25, as amended, requires:

- (a) a lateral restraint of a ski-lift chair;
- (b) a body member forming a downwardly facing, semi-cylindrical recess along a width of the body member, the recess receiving the lateral restraint therein;
- (c) at least one frame member that mounts over a top surface of the body member; and
- (d) printed media held between the at least one frame member and the body member.

The Examiner states: "Thomas discloses the applicant's basic inventive concept except for attaching the display to a restraint bar of a ski-lift chair." Office Action, page 9. Applicant points out, first, that Thomas does not disclose element (b) of claim 25. As argued in connection to the rejection of claim 12 under 35 U.S.C. §102(b) over Thomas, Thomas does not disclose a body member forming a downwardly facing, semi-cylindrical recess along a width of the body member.

The Examiner continues: "DeMasi shows in figures 1 and 2 the idea of attaching a display (32) to a restraint of a ski-lift chair. In view of the teachings of DeMasi it would have been obvious to one in the art to modify Thomas by attaching the display device to a restraint of a ski-lift chair since this would allow the device to be used on a wider range of articles for displaying any desired information." We disagree, and point out that Thomas and DeMasi are directed to non-analogous art and that no motivation exists to combine their teachings. Thomas is related to the art of automobile horns, while DeMasi is related to display systems for ski-lift chairs. One concerned with finding a solution for a display system for a ski-lift chair would not look to the art of automobile horns to find such a solution, and vice versa. Also, no motivation exists, in the cited art or in the knowledge generally available to one of ordinary skill in the art, to combine Thomas' and DeMasi's teachings. Thomas' objectives include "to provide a relatively large button which is of sufficient areal extent to reside within easy-to-reach range of the operating thumb," "has to do with a horn ring press-button which is characterized by a base and means for separably and adjustably clamping the same on the ring, ..." and "It is also within the purview of the inventive concept to provide a base of light weight economical material, simple means for clamping the same on the horn ring, said base having clasps for holding the cover or face plate in position and the latter, if desired, being of transparent plastics appropriately covered and serving to hold an escutcheon plate or an insignia plate on the base between the latter and the facing plate." Thomas, col. 1, lines 25-28, 36-39 and 45-54. None of these objectives are met by attaching Thomas' device to a restraint of a ski-lift chair. Arguably, doing so would thwart the intended operation of Thomas' device, because a user would not have his or her hands on a steering wheel, and/or need to operate an automobile horn, while seated on a ski-lift chair.



Since (1) even when combined, Thomas and DeMasi do not teach or suggest all the limitations of claim 25, (2) the cited art, and the knowledge generally available to one of ordinary skill in the art, do not supply motivation to modify the cited art or to combine reference teachings, and (3) Thomas and DeMasi are directed to non-analogous art, Thomas in view of DeMasi do not render claim 25 obvious, given the criteria of *In re Vaeck*. Furthermore, the combination proposed by the Examiner would render the prior art unsatisfactory for several of its intended purposes, so under *In re Gordon*, no motivation exists to combine the references. Therefore we request the reconsideration and withdrawal of the rejection of claim 25 under 35 U.S.C. §103(a) as unpatentable over Thomas in view of DeMasi.

Each of claims 30-33 depends directly or indirectly from claim 25, and thus benefits from like arguments; we therefore request reconsideration of and withdrawal of the rejection of claims 30-33 under 35 U.S.C. §103(a) as unpatentable over Thomas in view of DeMasi. However, these claims also contain limitations that patentably distinguish over Thomas in view of DeMasi.

For example, claim 30 as amended requires “the body member forming a plurality of molded recesses for securing screws, and screws that screw upwardly into the molded recesses, to facilitate attaching the body member to the lateral restraint.” The Examiner again takes official notice that it is known to form molded screw recesses; we again request evidence supporting this assertion, pursuant to MPEP §2144.03(C). Absent such evidence, we contend that Thomas in view of DeMasi do not show all of the elements of claim 30, and we request reconsideration of and withdrawal of the rejection of claim 30 under 35 U.S.C. §103(a) as unpatentable over Thomas in view of DeMasi.

Claim 31 requires (a) at least one loop member having a top flange and a bottom flange that project tangentially from a circle formed by the loop member, the top flange and the bottom flange forming aligned holes such that the loop member encircles the lateral restraint, and (b) a screw passing through the aligned holes into one of the molded recesses. The Examiner states, “In regard to claims 31-33, Thomas shows in figures 2 and 3 a plurality of loops (30) having flanges on each end and screws (34). It is considered within one skilled in the art to make the rivets (32) in the form of screws (34) since this would allow the loops to be removed in an easier matter to ease of

shipping and storage.” Office Action, page 9. However, neither Thomas’ loops nor screws teach or suggest the limitations of claim 31. Thomas’ “embracing clip 30” that the Examiner likens to a “loop” has neither a top flange nor a bottom flange, and especially not a top flange and a bottom flange that project tangentially from a circle formed by the loop member. Since these flanges do not exist, they also do not form aligned holes through which a screw - not a plurality of screws, or even rivets - may pass. DeMasi is silent with regard to screws. Since Thomas in view of DeMasi do not teach or suggest all of the elements of claim 31, we request reconsideration and withdrawal of the rejection of claim 31 under 35 U.S.C. §103(a) as unpatentable over Thomas in view of DeMasi.

Claim 32 requires a plurality of the same loop member as required by claim 31. For reasons such as listed with respect to claim 31, we request reconsideration and withdrawal of the rejection of claim 32 under 35 U.S.C. §103(a) as unpatentable over Thomas in view of DeMasi.

Claim 33 requires the same plurality of loop members as required by claim 32, and requires that the body member form at least one pair of twin holes, a forward hole of each pair corresponding to each molded recess and a rearward hole of each pair being situated rearward from the semi-circular recess, wherein a screw for each of the loop members may attach to either of the twin holes. The Examiner’s remarks with respect to claims 31-33 are quoted above, and do not contain any reference to pairs of twin holes, the required location of the forward and rearward hole of each pair, or the ability of a screw for each of the loop members to attach to either of the twin holes. Therefore the Examiner has not made a showing of prior art that includes all of the claim 33 limitations, and Applicant contends that *prima facie* obviousness has not been established for claim 33. Applicant refers to the explanation of Office Policy in MPEP §2142 and §707.07(d) as cited in connection with claim 25, above. Absent a showing of *prima facie* obviousness to the contrary, Applicant contends that claim 33 is not unpatentable under 35 U.S.C. §103(a) over Thomas in view of DeMasi and Smith, and requests reconsideration and withdrawal of the rejection of claim 33 as unpatentable over Thomas in view of DeMasi and Smith. If the Examiner disagrees, Applicant reserves the right to respond to a corrected or subsequent non-final Office Action that clearly explains the Examiner’s reasons for such rejection.

Claims 26 and 27 stand rejected as being unpatentable over Thomas in view of DeMasi and further in view of Smith.

With respect to claim 26, Applicant notes that no arguments are directed, directly or indirectly, to claim 26, and thus the Examiner fails to establish *prima facie* obviousness. Applicant refers to the explanation of Office Policy in MPEP §2142 and §707.07(d) as cited in connection with claim 25, above. Absent a showing of *prima facie* case of obviousness to the contrary, Applicant contends that claim 26 is not unpatentable under 35 U.S.C. §103(a) over Thomas in view of DeMasi and further in view of Smith, and requests reconsideration and withdrawal of the rejection of claim 26 as unpatentable over Thomas in view of DeMasi and Smith. If the Examiner disagrees, Applicant reserves the right to respond to a corrected or subsequent non-final Office Action that clearly explains the Examiner's reasons for such rejection.

Claim 27 requires "the printed media comprising imagery that is reverse printed on a bottom side of a clear plastic film." We point out that all of the cited art is non-analogous art with respect to each other. Thomas is directed to an "Automobile Horn Ring Press Button," DeMasi discloses a "Ski Lift Chair Map" and Smith discloses a "Window Badge." One skilled in any of these arts would not consult the others for guidance. Reconsideration and withdrawal of the rejection of claim 27 under 35 U.S.C. §103(a) as unpatentable over Thomas in view of DeMasi and Smith is requested.

Claim 28 stands rejected as being unpatentable over Thomas in view of DeMasi and further in view of U.S. Patent No. 4,104,818 ("Hrabik"). Applicant disagrees on the grounds that (1) claim 28 depends from claim 25, and benefits from the arguments above for patentability of claim 25, that (2) Thomas in view of DeMasi and/or Hrabik do not disclose all of the limitations of claim 28 and that (3) Thomas, DeMasi and Hrabik are directed to non-analogous art, with no motivation to combine the teachings of these references.

The Examiner states, "Hrabik shows in figures 1-2 a frame member (1) with tabs (7) which engage holes (8) in a media display." But this is not true; Hrabik discloses spreading bars having teeth which fit into a slide film: "The spreading bars 6 carry teeth 7 which fit into perforations 8 formed in the slide film F." Hrabik, col. 4, lines 7-9. A slide film is not printed media as required by claim 28.

The Examiner continues: "In view of the teachings of Hrabik it would have been obvious to one in the art to modify Thomas by placing tabs on the frame member and holes in the printed media since this would help to ensure that the printed media is properly aligned for viewing." Office Action, page 10. But this theory of motivation fails for two reasons. First, Thomas is directed to an "Automobile Horn Ring Press Button," DeMasi discloses a "Ski Lift Chair Map" and Hrabik discloses a "Slide Frame" related to the art of slide projectors. One concerned with any of these fields would not look to any of the others for solutions. Second, it is noted that Thomas' device mounts on a steering wheel that, by its nature, changes orientation during use. Material displayed therein would be rotated along with the steering wheel, rendering any attempt to "ensure printed media is properly aligned for viewing" pointless. Locating Thomas' device on a ski-lift chair, as the Examiner alleges is suggested by DeMasi, is likewise futile for the reason that a user of an automobile cannot simultaneously use a ski lift, as pointed out above. Therefore, no motivation exists to modify Thomas' device as per the teaching of DeMasi or Hrabik.

Since (1) even when combined, Thomas, DeMasi and Hrabik do not teach or suggest all the limitations of claim 12, (2) the cited art and the knowledge generally available to one of ordinary skill in the art, do not supply motivation to modify the cited art or to combine reference teachings, and (3) Thomas, DeMasi and Hrabik are directed to non-analogous art, Thomas in view of DeMasi and Hrabik do not render claim 25 obvious under the criteria of *In re Vaeck*. Furthermore, the combination proposed by the Examiner renders the prior art unsatisfactory for its intended purpose, so under *In re Gordon*, no motivation exists to combine the references. Therefore we request the reconsideration and withdrawal of the rejection of under 35 U.S.C. §103(a) as unpatentable over Thomas in view of DeMasi and Hrabik.

Claim 29 stands rejected as being unpatentable over Thomas in view of DeMasi and further in view of Sprenger. Applicant disagrees on the grounds that (1) claim 29 depends from claim 25, and benefits from the arguments above for patentability of claim 25, that (2) Thomas in view of DeMasi and/or Sprenger do not disclose all of the limitations of claim 28, that (3) the cited art, and the knowledge generally available to one of ordinary skill in the art, do not supply motivation to modify the references or to

combine reference teachings, and that (4) Thomas, DeMasi and Spresser are directed to non-analogous art, with no motivation to combine the teachings of these references.

The Examiner states, *inter alia*, "Spreser et al. shows in figures 1 and 2 a frame member (26) that includes two frame members (one receives card 104 and the other card 106)." Office Action, page 8. As per the remarks in connection with claim 14 above, Spreser actually refers to element 26 as "a generally rectangular cover member 26," and furthermore, the Examiner first states that frame member 26 is a frame member, then, that it is two frame members. Spreser does not actually teach frame members at all, but rather teaches "a generally rectangular cover member." Therefore, Thomas in view of Spreser does not teach or suggest the "a central frame member, a left frame member and a right frame member" limitations of claim 29.

Applicant disagrees for reasons similar to the remarks made with respect to claim 14 above, pointing out that there is no motivation to combine Spreser and/or DeMasi with Thomas, either as alleged by the Examiner or otherwise. An automobile driver certainly does not need or want more information sheets to be displayed on a button whose stated purpose is to provide easy-to-reach access to a horn ring. A shopper certainly does not need easy-to reach access to a horn button. Neither an automobile driver nor a shopper would be riding a ski-lift chair. Thomas, DeMasi and Spreser are non-analogous art, related to completely different fields of endeavor: Thomas is related to the field of automobile horns. DeMasi relates to the field of media display systems for ski-lift chairs. Spreser is related to the field of advertising display units for shopping carts.

Since Thomas, DeMasi and Spreser do not teach or suggest all of the elements of claim 29, and no motivation exists to combine the teachings of Thomas, DeMasi and Spreser, and Thomas, DeMasi and Spreser are non-analogous art to each other and to the field of media displays for ski-lift chairs, we contend that these references do not make claim 29 obvious. We accordingly request reconsideration and withdrawal of the rejection of claim 29 under 35 U.S.C. §103(a) as unpatentable over Thomas in view of DeMasi and Spreser.

**Conclusion**


In view of the above Amendments and Remarks, Applicant has addressed all issues raised in the Office Action dated 15 March 2006, and respectfully solicits a Notice of Allowance. Should any issues remain, the Examiner is encouraged to telephone the undersigned attorney.

The \$60 fee for a one-month extension of time for a small entity is enclosed herewith. Applicant believes no other fees are currently due, however, if any fee is deemed necessary in connection with this Amendment and Response, please charge Deposit Account No. 12-0600.

Respectfully submitted,

LATHROP & GAGE L.C.

Date: 7/17/06

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